REMARKS

I. Summary of the Office Action

Claims 1-109 were pending in this application.

Claims 1-6, 8, 10, 11, 13-16, 18, 19, 23, 24, 26-33, 35, 37, 38, 42-44, 48, 49, 53, 54, 56, 57, 60, 62-64, 66-69, 71, 74, 77, 78, 80, 81, 86, 89-91, 93-96, 99, 100, 103, 106, 107, and 109 were rejected under 35 U.S.C. § 103(a) as being obvious from Inoue et al. U.S. Patent No. 5,884,141 ("Inoue") in view of Lortz U.S. Patent No. 6,349,410 ("Lortz").

Claims 7, 9, 34, 36, 65, and 92 were rejected under 35 U.S.C. § 103(a) as being obvious from Inoue in view of Lortz, and in further view of Ismail et al. U.S. Patent No. 6,614,987 ("Ismail").

Claims 12, 17, 39, 45-47, 58, 59, 61, 70, 82-85, 87, 88, 97, and 98 were rejected under 35 U.S.C. § 103(a) as being obvious from Inoue in view of Lortz, and in further view of Baker et al U.S. Patent No. 5,583,561 ("Baker").

Claims 20, 21, 50, 51, 75, and 104 were rejected under 35 U.S.C. § 103(a) as being obvious from Inoue in view of Lortz, and in further view of Banker et al. U.S. Patent No. 5,357,276 ("Banker").

Claims 22, 25, 52, 55, 72, 73, 76, 79, 101, 102, 105, and 108 were rejected under 35 U.S.C. § 103(a) as being

obvious from Inoue in view of Lortz, and in further view of White et al. U.S. Patent No. 6,392,664 ("White").

II. Summary of Applicants' Reply

Applicants have amended independent claims 1, 27, 57, and 81 to more particularly define the invention. Applicants have canceled claims 6, 8, 33, 35, 64, and 91 without prejudice and have added new claims 124-129. No new matter has been added and the amendments are fully supported by the originally filed specification.

The Examiner's rejections are respectfully traversed.

III. Applicants' Reply to the Rejections of Claims 1 and 27

Applicants' amended independent claims 1 and 27 are directed to a method and system for substituting pause-time content in place of media that is paused using an interactive media application. A pause-time content database is provided for storing pause-time content, and a user is provided with the ability to pause media. Local to the user, pause-time content is determined and the determined pause-time content is played while the media is paused.

The Examiner rejected applicants' previously pending claims as being obvious from the combined teachings of Inoue and Lortz. In particular, the Examiner attempted to

combine the teachings of Inoue, which describes a near-video-on-demand system that displays uninspired content during a pause (e.g., another program, a pause graphics screen), with that of Lortz, which allows a user to pause a program to view web content.

Applicants respectfully disagree with the Examiner's contentions. Among other things, applicants respectfully submit that the Examiner has employed hindsight reconstruction in combining these references, and has not provided a convincing and explicit reason for why one of ordinary skill in the art would have combined the references in the manner suggested by the Examiner. However, in the interest of advancing prosecution, applicants have amended claims 1 and 27 to include the feature of locally determining the pause-time content that is displayed when the media is paused. Applicants hereby reserve the right to pursue the subject matter of the previously pending claims in any continuation or divisional applications.

For at least the following reasons, applicants respectfully submit that independent claims 1 and 27, as amended, are allowable over Inoue and Lortz.

A. The combination of Inoue and Lortz does not show all of the features of applicants' claimed invention

Applicants respectfully submit that the combination of Inoue and Lortz fails to show applicants' claimed feature of "local to the user, determining pause-time content to display while the media is paused," as specified by applicants' claim 1.

Inoue refers to different content that can be displayed during a pause (e.g., a program, a graphics screen, etc.). However, Inoue does not show or suggest that the system can choose between the different content displayed during a pause. Therefore, Inoue fails to show that displayed pause-time content is determined locally.

Lortz refers to a system in which a URL embedded in the vertical blanking interval of a television broadcast can be used to display a web page when the television program is paused. This URL is inserted into the broadcast TV signal stream by a broadcaster or other provider of TV programming signals (see col. 3, 29-39). Local to the user, the set top box merely obtains and displays the web content associated with the inserted URL in response to a forward command. Therefore, the particular web page displayed during a pause is determined by a source remote from the user. Accordingly, Lortz also fails to show or suggest that pause-time content

is determined local to the user, as specified by applicants' independent claims 1 and 27.

Thus, neither Inoue nor Lortz show or suggest that pause-time content can be determined local to the user. Therefore, the combined teachings of Inoue and Lortz fail to show or suggest this feature of applicants' claimed invention. For at least the reason that the combination of Inoue and Lortz fails to show applicants' claimed "local to a user, determining pause-time content to display while the media is paused," applicants respectfully submit that applicants' independent claims 1 and 27 are allowable over Inoue and Lortz.

B. Applicants' claimed invention is nonobvious in view of Inoue and Lortz

In applicants' previous Reply to Office Action, filed February 2, 2007, applicants submitted arguments as to why one of ordinary skill would not find the subject matter of applicants' claimed invention obvious from the teachings of Inoue and Lortz. However, in the Office Action, the Examiner did not show that these remarks were evaluated along with the facts on which the conclusion of obviousness was reached, as required by MPEP § 2142. In fact, the Examiner did not address these arguments at all. Applicants respectfully request that the Examiner consider these

previously filed remarks and include a response to the remarks in the next Office communication.

Applicants respectfully submit that the § 103 rejection of applicants' claims is improper, because the subject matter of applicants' claimed invention is nonobvious from the teachings of Inoue and Lortz. "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." Stratoflex, Inc. v. Aeroquip Corp. , 713 F.2d 782, 218, USPQ 698 (Fed. Cir. 1983). Based on the scope and teachings of Inoue and Lortz, as described below, the subject matter of applicants' claimed invention would not be obvious to one of ordinary skill in the art.

Inoue refers to providing a pause function in a near-video-on-demand system. When a pause is requested, the system only stores a segment of the paused program, and can obtain the remainder of the program from another channel carrying the same program (abstract). Thus, Inoue is directed generally to taking advantage of near-video-on-demand features to provide a pause function. Inoue, however, does not focus on selecting particular content to be displayed during a pause.

In contrast, Lortz provides a way to coordinate the display of television programming and web content. That is, a viewer can access web content, if available, by pressing a forward button, and can return to the television program at a later time. This can be accomplished by pausing the television program while the user accesses the web content. The pause function is therefore a derivative action of a viewer accessing web content, not the action requested by the user. Thus, Lortz is directed generally to providing two types of content on one display.

Applicants' claimed invention, on the other hand, provides enticing, relevant, and unexpected content to a user when the user wants to pause a media program (e.g., when the user needs to leave the room). As neither Lortz nor Inoue show or suggest this novel idea, the overall subject matter of applicants' claimed invention is not obvious from the combined teachings of the Lortz and Inoue. Thus, but for applicants' own specification, one would not think to combine the teachings of Inoue with that of Lortz. The Examiner's rejection could therefore have only been made using hindsight reconstruction, which is impermissible as a matter of law.

For at least the foregoing reasons, applicants respectfully submit that claims 1 and 27 are allowable over the teachings of Inoue and Lortz.

IV. Applicants' Reply to the Rejections of Claims 57 and 81

Applicants' amended independent claims 57 and 81 are directed to a method and system for substituting pause-time content in place of media that is paused using an interactive media application. A user is provided with the ability to pause media. Local to the user, pause-time content with a subject matter related to the subject matter of the media is determined, and the determined pause-time content is played while the media is paused.

As described above, the combined teachings of Inoue and Lortz fail to show applicants' claimed "local to the user, determining pause-time content to display while the media is paused." For at least this reason, applicants respectfully submit that applicants' claims 57 and 81 are not obvious in view of the combination of Inoue and Lortz. Therefore, applicants' respectfully submit that applicant's independent claims 57 and 81 are allowable over Inoue and Lortz. Applicants respectfully request that the rejection of these claims be withdrawn.

V. Applicants' Response to the Rejection of the Dependent Claims

Applicants have shown that independent claims 1, 27, 57, and 81 are allowable over Inoue and Lortz. Dependent claims 2-5, 7, 9-26, 28-32, 34, 36-56, 58-63, 65-80, 82-90,

and 92-109, which variously depend from allowable claims 1, 27, 57, and 81, are also allowable at least because they depend from allowable claims. Applicants respectfully request that the rejections of these claims be withdrawn.

Furthermore, applicants respectfully submit that claims 23, 24, 53, 54, 77, 78, 106, and 107 are allowable for at least the additional reasons described below.

A. Dependent Claims 23, 24, 53, 54, 77, 78, 106 and 107

Applicants' claims 23, 53, 77, and 106, which depend from independent claims 1, 27, 57, and 81, respectively, further specify that a user may select particular types of pause-time content. As illustrated by claims 24, 54, 78, and 107, types of pause-time content can include an advertisement, a promotion, a trivia game, a musical selection, a graphic, an animation, a program summary, a textual description, and a Web site.

The Examiner contends that Lortz shows this features of applicants' claimed invention. However, Lortz only provides websites when a program is paused. As Lortz shows only one type, Lortz clearly cannot show or suggest that a user may select particular types of pause-time content to be presented. Therefore, for this additional reason, applicants respectfully submit that applicants' claims 23,

53, 77, and 106 are allowable over Inoue and Lortz. Claims 24, 54, 78, and 107, which depend from allowable claims 23, 53, 77, and 106, respectively, are also allowable at least because they each depend from an allowable claim. Applicants respectfully request that the rejection of claims 23, 24, 53, 54, 77, 78, 106 and 107 be withdrawn.

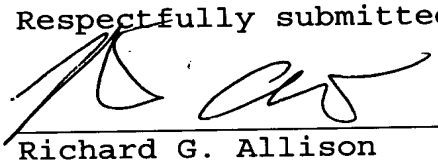
VI. New Claims 124-129

Applicants have added new claims 124-129. These new claims specify particular ways in which pause-time content can be determined locally. In particular, claims 124 and 126 specify that pause-time content can be determined according to monitored user activity. Claims 125 and 127-129 specify that pause-time content can be determined according to channel information for a television program. Support for these new claims can be found in applicants' specification, for example, at p. 15, l. 9 through p. 16, l. 9, and p. 18 l. 27 through p. 19, l. 9. Applicants respectfully submit that new claims 124-129 are allowable over Inoue and Lortz, because neither Inoue nor Lortz, nor their combination, show or suggest the above features. Moreover, applicants respectfully submit that new claims 124-129, which variously depend from allowable claims 1, 27, 57, and 81, are allowable at least because they depend from allowable claims.

VII. Conclusion

In view of the foregoing, claims 1-5, 7, 9-32, 34, 36-63, 65-90, 92-109, and 124-129 are in condition for allowance. This application is therefore in condition for allowance. Reconsideration and allowance of this application are respectfully requested.

Respectfully submitted,



Richard G. Allison
Registration No. 60,386
Agent for Applicants
FISH & NEAVE IP GROUP
ROPES & GRAY LLP
Customer No. 1473
1211 Avenue of the Americas
New York, New York 10036-8704
Tel.: (212) 596-9000
Fax: (212) 596-9090